

REMARKS

The above amendment and these remarks are responsive to the Office Action of Examiner Eric T. Shaffer mailed 12/30/2002.

Independent claims 1, 6, 7, 8, and 9 have been amended to more distinctly set forth an important feature of the present invention, to wit, the determination of the optimum level of demanufacturing of a product to recover the largest revenue possible. Dependent claims 3 and 4 have been cancelled without prejudice; the limitations of claim 3 have been incorporated into claim 2. Entry of this amendment is urged.

Claims 1, 2, and 5-10 are in the case, none having been allowed.

35 U.S.C. § 103

Claims 1-4 and 6-10 have been rejected under 35 USC 103(a) as being unpatentable over Suzuki et al. (US 5,965,858) in view of Graff (US 6,192,347). Claim 5 has been rejected under 35 USC 103(a) as being unpatentable over Suzuki et al. (US 5,965,858) in view of Graff (US 6,192,347), and further in view of the Microsoft Computer Dictionary.

Applicants submit herewith a declaration under 37 C.F.R 1.131 stating that the present invention was conceived and actually reduced to practice prior to the August 14, 1998 filing date of Graff. Applicants therefore respectfully request that Graff be withdrawn from further consideration, and that the 35

U.S.C. 103(a) rejection based on Graff be withdrawn pursuant to MPEP 715.02.

Neither Suzuki et al. alone, nor Suzuki et al. in view of the Microsoft Computer Dictionary disclose all of applicants' steps of: providing a product for demanufacturing, said product having a plurality of parts, wherein each of said parts comprises one or more commodities, collecting one or more resale prices for one or more of said parts respectively, collecting one or more commodity prices for one or more of said commodities respectively, determining the labor expense to remove said each of said parts from said product, entering said resale prices, said commodity prices, and said labor expense into a computer or spreadsheet model, executing said computer or spreadsheet model to determine a highest commodity value, executing said computer or spreadsheet model to determine a highest removed parts value, and executing said computer or spreadsheet model to optimally determine which of said parts to remove from said product to provide greatest economic benefit by recovering largest revenue as required by applicants' amended independent claims 1, 6, 7, 8, and 9.

Also, while Suzuki et al. discloses that "by taking into consideration the necessity of modifying the recycling rules and the recycle method decision procedure, as occasion demands, since new recycle processing methods will be developed from one to another with the optimal recycle processing method changing correspondingly" in column 8, lines 61-67, this refers to manually changing "recycling rules" to determine an "optimal recycle processing method". This is shown in column 5, lines 65-66 of Suzuki et al. where it is stated that "recycle processing for a given article" is determined "in accordance with the

recycling rules prepared previously". Nowhere does Suzuki et al. disclose executing a computer or spreadsheet model to optimally determine which of parts to remove from a product to provide greatest economic benefit by recovering largest revenue as required by applicants' amended independent claims 1, 6, 7, 8, and 9.

Accordingly, inasmuch as Suzuki et al. and Microsoft Computer Dictionary, neither by themselves, nor in combination, teach or suggest all of the steps, elements, or limitations required by applicants' amended Claims as is required in a 35 U.S.C. 103(a) rejection pursuant to MPEP 2143.03, it is respectfully requested that the Examiner withdraw the rejection of applicants' amended independent claims 1, 6, 7, 8, and 9 under 35 U.S.C. 103(a), and allow claims 1, 6, 7, 8, and 9. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (emphasis added) Also, "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claims 3 and 4 have been cancelled without prejudice which renders the rejection thereof moot.

It appears as though the substance of claim 5 may have may misapprehended. Claim 5 recites a type of computer model which is executed to optimally determine which parts to remove from a product to provide greatest economic benefit by recovering largest revenue, rather than merely a method or means for inputting and/or storing information.

Furthermore, claims 2 and 5 depend from allowable claim 1, and claim 10 depends from allowable claim 9. Claims 2, 5, and 10 are therefore also allowable. Pursuant to MPEP 2143.03, "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, it is respectfully requested that the Examiner withdraw the rejection of applicants' dependent claims 2, 5, and 10 under 35 U.S.C. 103(a), and allow claims 2, 5, and 10.

The Application is deemed in condition for allowance and such action by the Examiner is urged. Should differences remain, however, which do not place one/more of the remaining claims in condition for allowance, the Examiner is requested to phone the undersigned at the number provided below for the purpose of providing constructive assistance and suggestions in accordance with M.P.E.P. Sections 707.02(j) and 707.03 in order that allowable claims can be presented, thereby placing the Application in condition for allowance without further proceedings being necessary.

Respectfully Submitted,

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